

REMARKS

Claims 1 through 9 and 11 through 14 are pending in this Application. Applicant acknowledges, with appreciation, the Examiner's allowance of claims 7 through 9, 13 and 14, and the Examiner's indication that claims 2 and 3 contain allowable subject matter. Accordingly, the only remaining issue pivots about the patentability of claims 1, 4 through 6, 11 and 12.

Claims 1 and 2 have been amended to address apparent typographical oversights. Applicant submits that the present Amendment does not generate any new matter issue.

Claims 1, 4 through 6, 11 and 12 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Yano et al.

In the statement of rejection the Examiner referred to various portions of the patent text, asserting that Yano et al. disclose an electroluminescent device corresponding to that claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). When imposing a rejection under the first paragraph of 35 U.S.C. § 102 for lack of novelty, it is incumbent upon the Examiner to specifically identify wherein an applied reference is asserted to identically disclose each and every feature of a claimed invention, particularly when such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531, 28

USPQ2d 1955 (Fed. Cir. 1993); Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Indeed, there is a fundamental difference between the claimed electroluminescent device and that disclosed by Yano et al. that scotches the factual determination that Yano et al. disclose an electroluminescent device identically corresponding to that claimed.

Specifically, each of independent claims 1 and 11 is directed to an electroluminescent device comprising, *inter alia*, a light emitting layer formed of the second compound semiconductor of Group IIa-VIb and an underlayer formed of a first compound semiconductor layer of Group IIa-VIb, wherein the first compound semiconductor and the second compound semiconductor have the same crystalline structure. No such device is disclosed or suggested by Yano et al.

It should be apparent that Yano et al. disclose a light emitting layer 3 made of a compound semiconductor of Group IIa-VIb formed on a first insulating layer 2. However, the first insulating layer is exemplified by silicon nitride, silicon oxynitride, lead titanate and barium titanate. None of these materials is a compound semiconductor of Group IIa-VIb. Further, Yano et al. neither disclose nor suggest that the first insulating layer 2 and the light-emitting layer 3 are made of a compound semiconductor Group IIa-VIb having the same crystal structure.

The above argued difference between the claimed electroluminescent device and the device disclosed by Yano et al. undermines the factual determination that Yano et al. disclose an electroluminescent device identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).* Applicant, therefore, submits that the imposed rejection of claims 1, 4 through 6, 11

Application No.: 10/635,777

and 12 under 35 U.S.C. § 102 for lack of novelty as evidenced by Yano et al. is not factually viable and, hence, solicits withdrawal thereof.

Applicants again acknowledge, with appreciation, the Examiner's allowance of claims 7 through 9, 13 and 14, and the Examiner's indication that claims 2 and 3 contain allowable subject matter. Based upon the arguments submitted *supra*, it should be apparent that the imposed rejection has been overcome and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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